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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,582	12/19/2000	Man C. Niu	13402.00004	6349

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EXAMINER

BAUM, STUART F

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,582

Applicant(s)

NIU, MAN C

Examiner

Stuart F. Baum

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1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004 and 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,13,15,22,25,28-43,45,47-50,52,54,56,59,61 and 64-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,13,15,22,25,28-43,45,47-50,52,54,56,59,61 and 64-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 and 01 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The amendments filed 5/3/2004 and 11/26/2004 have been entered.
Claims 1-11, 13, 15, 22, 25, 28-43, 45, 47-50, 52, 54, 56, 59, 61, and 64-73 are pending.
Claims 12, 14, 16-21, 23-24, 26-27, 44, 46, 51, 53, 55, 57-58, 60, and 62-63 have been canceled.
2. Claims 1-11, 13, 15, 22, 25, 28-43, 45, 47-50, 52, 54, 56, 59, 61, and 64-73 are examined in the present office action.
3. Rejections and objections not set forth below are withdrawn.
4. The text of those sections of Title 35, U.S. Code not included in this office action can be found in a prior office action.

Claim Objection

5. Claims 11 and 13 are objected to for being duplicates of each other.
Claims 29 and 30 are objected to for being duplicates of each other.
Claims 31 and 32 are objected to for being duplicates of each other.
Claims 36 and 37 are objected to for being duplicates of each other.
Claims 38 and 39 are objected to for being duplicates of each other.
Claims 40 and 41 are objected to for being duplicates of each other.
Claims 64 and 65 are objected to for being dependent on canceled claims.

Indefiniteness

6. Claims 35-41, 49-50, 52, 54, 56, 59, and 61 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Rejection includes dependent claims.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “germinating” in claims 35, 49, 56, and 61 is used by the claim to mean “that the transgenic plant somehow becomes a second generation transgenic plant”, while the accepted meaning is “the initial growth of a seed after being placed in an environment conducive for growth.” The term is indefinite because the specification does not clearly redefine the term. This rejection is maintained for the reasons of record set forth in the Official action mailed 11/6/2003. Applicant’s arguments filed 5/3/2004 and 11/26/2004 have been fully considered but they are not persuasive.

Applicants contend the term germinating has been used in a manner consistent with the accepted meaning of the term (second page of the remarks, 2nd full paragraph filed 5/3/2004).

The Office contends that the term “germinating” is reserved for the initial growth of seeds, as stated in the previous office action, and Applicants use of the term is indefinite.

Enablement

7. Claims 1-11, 13, 15, 22, 25, 28-43, 45, 47-50, 52, 54, 56, 59, 61, and 64-73 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is maintained for the reasons of record set forth in the Official action mailed 3/21/2002.

Applicant's arguments filed 5/3/2004 and 11/26/2004 have been fully considered but they are not persuasive.

Applicants contend that the application is enabling for isolating and purifying soy globulin mRNA and moreover, the invention is not limited to the embodiment disclosed in the application. Applicants contend that total poly mRNA has been isolated from soy globulin in soy sprouts and Applicant has isolated and purified soy globulins as recited in the claims.

Applicants contend that two exemplary corn varieties expressing soy globulin protein have been presented. Applicants contend that given the disclosed information, one of ordinary skill in the art can transform plants and seeds using mRNA using the teachings of the invention (2nd page of the remarks, 3rd paragraph filed 5/3/2004).

The Office contends that Applicant has not disclosed how one skilled in the art isolates soy globulin mRNA from the total mRNA isolated from soy sprouts. Applicant has isolated total mRNA and used said mRNA to inject into corn kernels. The Office contends that Applicant has only isolated total poly mRNA from soy cotyledons or soy sprouts and has not isolated and purified soy globulin mRNA as is recited in the claims. Applicant is claiming all transgenic corn kernels and corn plants, as well as a method for producing transgenic plants expressing any

exogenous protein but Applicant has only exemplified 2 corn varieties only expressing soy globulin protein and in addition, Applicant has disclosed that different corn varieties exhibit different competencies to being transformed, (See page 14, lines 14-24 and Table 1, in Applicant's specification). In addition, Applicant's claims are also directed to incubating any seed with mRNA. Also, Applicant has not disclosed by way of example or guidance how one skilled in the art can transform all plants by incubating a seed with mRNA. Given the arguments filed in the previous three Office actions, and the presently stated remarks, undue experimentation would be required by one skilled in the art to make and/or use the broadly claimed invention.

Allowable Subject Matter

8. It was noted in the office action dated 11/6/2003 that claims 33 and 47 would be allowable if re-written in independent form to include all limitations. In the amendment filed 5/3/2004, Applicant has removed limitations to the claims which now make the claims not allowable, i.e., of corn variety 27-1.

9. No claims are allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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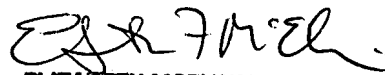
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart F. Baum whose telephone number is 571-272-0792. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Stuart F. Baum Ph.D.
Patent Examiner
Art Unit 1638
February 15, 2005


ELIZABETH MCELWAIN
PRIMARY EXAMINER